

*REMARKS/ARGUMENTS**The Restriction Requirement*

The Office has required restriction between the following three groups of claims:

Group I (claims 1-7 and 13-21) directed to a method of changing the sensory perception of an animal comprising administering to the inner ear an adeno-associated viral vector comprising a nucleic acid sequence encoding an atonal-associated factor;

Group II (claims 1-6 and 8-21) directed to a method of changing the sensory perception of an animal comprising administering to the inner ear an adenoviral vector comprising a nucleic acid sequence encoding an atonal-associated factor; and

Group III (claim 22-34) directed to a method of generating a hair cell in differentiated sensory epithelia *in vivo*.

Additionally, the Office Action requires that Applicants elect a species with respect to the neurotrophic agent recited in claim 15.

Applicants' Election

Applicants elect, with traverse, the claims of Group II (claims 1-6 and 8-21) for further prosecution. In response to the election of species requirement, Applicants elect, with traverse, the species nerve growth factor.

While Applicants have provided an election for the aforementioned specific species, the species election merely is intended to aid the Examiner in the search and examination of the present patent application. The election is by no means indicative of Applicants' willingness to ultimately limit the claims of the present application to this specie. As acknowledged in the Office Action, and consistent with an election of species requirement, Applicants are entitled to consideration of additional species encompassed by the generic claims upon a determination that the elected specie is patentable.

Discussion of the Restriction Requirement

There are two separate criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, and (ii) there must be a serious burden on the Examiner if restriction is not required. Both of these criteria must exist for a restriction requirement to be proper, and “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions” (M.P.E.P. § 803).

Applicants respectfully submit that the restriction requirement as between the claims of Groups I-III is improper because the nature of the claims is such that any burden encountered in searching the groups together would, at most, be slight (and certainly not “serious”). Moreover, the fact that a patentability search for one group of claims may not be “coextensive” with the patentability search for another group of claims, as the Office Action alleges, does not necessarily mean that conducting such searches concurrently would place a “serious burden” on the Examiner. Indeed, since all of the pending claims relate to methods of changing the sensory perception of an animal, such as by generating hair cells, comprising administration of a viral gene transfer vector, it would appear that there would be no “serious burden” on the Examiner to address all of the pending claims at one time. In the absence of such a “serious burden,” the restriction requirement is improper even if groups of claims are drawn to distinct or independent inventions. As such, any search and consideration of the claimed subject matter of elected Group II will overlap the search and consideration of the claimed subject matter of Groups I and III.

Accordingly, there would appear to be sufficient similarity between the claims of Groups I-III to allow for the search and examination of the subject matter of all of the claims at the same time without a “serious burden” being placed on the Examiner. Applicants, therefore, respectfully request withdrawal of the Restriction Requirement, and respectfully submit that the claims of Groups I-III should be examined together or, at the very least, the claims of Groups II and III.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned agent.

Respectfully submitted,



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